

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 8-21 are pending in this application. Claim 8 is amended. Claims 15-21 are newly added. No claims are cancelled by this amendment.

Applicants acknowledge with appreciation the Examiner's indication that the references included in the Information Disclosure Statement filed March 24, 2005 have been acknowledged as considered by the Examiner.

Applicants respectfully request that the Examiner acknowledge that a certified copy of the priority document has been received and that the drawings have been accepted by the United States Patent and Trademark Office (USPTO).

Specification

The specification has been amended to include paragraph [0016.1] as shown in the preceding section. Support for paragraph [0016.1] is provided at least in paragraph [0017] of the original specification and original claim 11 filed on March 16, 2004. Further, Applicants respectfully note that MPEP § 2163.07 states the following.

Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

In light of the above, Applicants respectfully submit that no new matter is added by the amendment to the specification included in the preceding section of this amendment.

Claim Rejections under 35 U.S.C. § 112, first paragraph

Claim 11

Claim 11 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asks the question “where is the support for the ‘inversely proportional’ relationship?”

In response to the above rejection and question, Applicants respectfully submit that support for pending claim 11 is found at least in paragraph [0017] and original claim 11 of the original specification filed on March 16, 2004. Further, Applicants respectfully note that paragraph [0017] of the original specification has been rephrased as permitted by MPEP § 2163.07 and the slightly rephrased version of paragraph [0017] is included in the specification by the amendment included in the previous section of this amendment.

In light of the above, Applicants respectfully request that the rejection of claim 11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, be withdrawn.

Claim 11 also stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner poses the questions of “is the pressure varied over cycles on the

same disc,” and “if, not how does this method to test ‘an optical disc’ (lines 1-2 of claim 8) (i.e. a single disc) employ pressures/cycles that are applied to other (unrelated) discs?”

Initially, Applicants respectfully note that the Applicants’ specification does not use the term “cycle” and thus, Applicants respectfully submit that Examiner’s specific questions are somewhat unclear.

However, Applicants do note that the example in paragraph [0017] of the originally filed specification and original claim 11 are sufficient to satisfy the enablement requirement. The example recited in paragraph [0017] of the original specification states “the pressure applied to the scratcher is decided to be at a low level when the predetermined number of rotation turns of the optical disc is high, and at a high level when the predetermined number of rotation turns of the optical disc is low.” Applicants note that the information included in paragraph [0017] of the original specification was omitted from the substitute specification filed November 17, 2005. However, paragraph [0016.1] added by this amendment now reflects the information included in original paragraph [0017].

In light of the above, Applicants respectfully request that the rejection of dependent claim 11 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement, be withdrawn.

Claim Rejections under 35 U.S.C. § 102(b)

Claims 8 and 9

Claims 8 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hayashida et al. (U.S. Publication No. 2002/0054975, herein Hayashida). Applicants respectfully traverse this rejection for the reasons detailed below.

Initially, Applicants respectfully note that the method for testing an endurance of an optical disc of independent claim 8 recites, *inter alia*, “applying pressure **in a vertical direction on the optical disc** using a scratching unit while the optical disc rotates for a predetermined number of rotation turns, so as to produce a scratch on a surface of the optical disc, resulting from a contact with the scratching unit.” Applicants respectfully submit that at least this emphasized feature of amended independent claim 8 patentably distinguishes claim 8 over Hayashida.

In particular, paragraph [0091] of Hayashida, which is cited by the Examiner, specifically states that “[t]he abrasion test procedure using abrasive wheels prescribed by ISO 9352 is a test procedure commonly known as Taber abrasion test and is carried out as follows.” The remainder of paragraph [0091] goes on to describe the well-known Taber abrasion test reciting, *inter alia*, (1) “a predetermined load **is applied to the abrasive wheels**” and (2) “[d]uring rotation, the abrasive wheels abrade the sample surface while maintaining **a certain tilt to the rotational direction of the turntable.**”

Therefore, Applicants respectfully note that the well-known Taber abrasion test does not disclose, teach or suggest each and every feature of amended independent claim 8. In particular, the Taber abrasion test is performed by a load applied to the abrasive wheels and the load is applied at a

tilt, whereas independent claim 8 specifically recites “applying **pressure in a vertical direction on the optical disc.**”

In light of the above, Applicants respectfully request that the rejection of independent claim 8, and claim 9 depending therefrom, under 35 U.S.C. § 102(b) be withdrawn.

Claim Rejections under 35 U.S.C. § 103

Claims 10-14

Claims 10-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hayashida. Applicants respectfully traverse this rejection for the reasons detailed below.

Applicants respectfully note that claims 10-14 depend from independent claim 8, which has been distinguished over Hayashida above. In particular, Hayashida fails to disclose, teach or suggest a method including “applying pressure **in a vertical direction on** the optical disc using a scratching unit while the optical disc rotates for a predetermined number of rotation turns, so as to produce a scratch on a surface of the optical disc, resulting from a contact with the scratching unit,” as recited in amended independent claim 8.

Applicants also respectfully note that the Taber abrasion test referred to in paragraph [0091] of Hayashida is specifically referenced in the “Background of the Invention” section of the Applicants’ specification at page 3, paragraph [0007]. In particular, paragraph [0007] of the Applicants’ specification states the following.

Also, in the taber abrasion test, while using the abrasion wheel, the abrasive wear on the surface of the optical disc is very different from the scratches on the optical disc. Therefore, testing the endurance of the optical disc based on the abrasive wear caused by the abrasion wheel is not appropriate.

Applicants respectfully submit that this is further evidence that the example embodiments described in the Applicants' specification are not obvious in view of the Taber abrasion test.

In light of the above, Applicants respectfully request that the rejection of claims 10-14 under 35 U.S.C. § 103(a) be withdrawn.

Claim 12

Claim 12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hayashida as applied to claim 8 and further in view of Nakagawa et al. (U.S. Patent No. 5,343,733, herein Nakagawa). Applicants respectfully traverse this rejection for the reasons detailed below.

With respect to claim 12, the Examiner asserts that "it would have been obvious to employ a non-rotating test piece (in place of a wheel) in Hayashida as Nakagawa teaches that a test element 4 may effectively permit for abrasion testing of a rotating body."

However, The Nakagawa patent is directed towards a method of testing abrasion of automobile brake rotors. In the Nakagawa method, a brake rotor is attached to, for example, a vehicle axle, and then a brake pad material is applied to the rotor at two different pressures.

Applicants respectfully submit that Nakagawa is not analogous art to that of the subject invention and Hayashida, which the Examiner asserts is combinable with Nakagawa. Why one skilled in the art would look to the automobile brake rotor abrasion testing art is beyond Applicants' understanding.

Therefore, Applicants respectfully request that the Examiner withdraw the rejection at least because one skilled in the art would not be motivated to combine the teachings of Hayashida, which is directed towards an evaluation method for an optical information medium, with the teachings of Nakagawa directed towards automobile brake rotor abrasion testing.

In light of the above, Applicants respectfully request that the rejection of claim 12 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of above remarks, reconsideration of the outstanding rejection and allowance of the pending claims is respectfully requested.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants hereby petition for a two (2) month extension of time for filing a reply to the outstanding Office Action and submit the required \$450 extension fee herewith.

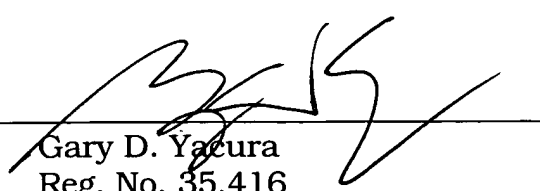
If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, PLC

By


Gary D. Yacura
Reg. No. 35,416

P.O. Box 8910
Reston, VA 20195
(703) 668-8000


GDY/SAE:ame